REMARKS

Applicant has carefully reviewed the Office Action mailed February 2, 2009 and offers the following remarks to accompany the above amendments.

Status of the Claims

Claims 61-64, 66-70, and 72-92 were previously pending. Claims 1-60, 65, 71, and 93-108 were previously cancelled. No claims are added or cancelled herein. As such, claims 61-64, 66-70, and 72-92 remain pending.

Drawings Objection

The Patent Office objected to the drawings under 37 C.F.R. § 1.83(a). The Patent Office asserted that the feature "select a matching user profile from the plurality of user profiles" must be shown or the feature cancelled from the claims. Applicant submits that such feature is already shown in the drawings. For example, referring to Figure 6 of the subject application, block 63 states: "USER'S PROFILE IS COMPARED TO OTHER PROFILES STORED IN THE PEER." Block 65 of Figure 6 is a decision block where the decision is based on the answer to the question: "IS AT LEAST ONE MATCH FOUND?" Applicant submits that such blocks fully show the corresponding feature "select a matching user profile from the plurality of user profiles" and as such, Applicant respectfully requests that the objection be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 61 and 78 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Patent Office asserted that the feature "select a matching user profile from the plurality of user profiles" is not fully supported by Applicant's Specification. Applicant respectfully disagrees, and directs the Examiner's attention to paragraphs [0090] and [0091] of the subject application. Such paragraphs state:

> [0090] The user's profile is communicated to a server (such as server 11 of FIGS. 1 and 2), as shown in block 32. At the server, the user's profile is compared to the profiles of other users as shown in block 33. An attempt is made to match the user's profile to the profile of one or more other users, so as to identify other users having similar tastes and interests.

> [0091] The playlists of one or more other users, whose profiles best match the user's profile, are communicated to the user's device as shown in block 34. Any desired method or algorithm for such matching may be used. For example, each time the responses to two questionnaires match, a number could be added to a score for that particular matching process. The matching processes that result in the highest scores could be considered close enough matches to cause a playlist to be sent. Alternatively, any matching process that result in a score that exceeds a predetermined threshold value may be considered a match. (Emphasis added).

Such paragraphs indicate that a user's profile is communicated to a server, where the profile is compared to the profiles of other users, and upon a match the playlists of one or more other users are communicated to the user's device. Applicant submits that paragraphs [0090] and [0091] clearly convey that the inventor had possession of the claimed invention as of the filing date of the present application. Applicant therefore respectfully requests the rejection be withdrawn.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 61 and 78 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Patent Office opined that the statements "effecting selection" and "effecting delivery" seem indefinite because "it is not known what effects selection and delivery as claimed" (Office Action mailed February 2, 2009, p. 4). While Applicant disagrees such limitations are indefinite, Applicant has amended claims 61 and 78 to recite "selecting" and "delivering" in lieu of "effecting selection" and "effecting delivery" respectively, and Applicant therefore submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103(a) – Chislenko and Chang

Claims 61-64, 66-70, 75, 77-81, 85, 87-90, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,041,311 to Chislenko et al. (hereinafter "Chislenko") in view of U.S. Patent Application Publication No. 2002/0168938 A1 to Chang (hereinafter "Chang"). Applicant respectfully traverses. When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir.

1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Chislenko discloses a system wherein items in a category, or "domain," may be recommended to a user of the system based on similarities of the rating of such items by the respective user and the rating of such items by a group of "neighboring users" of the system (Chislenko, col. 3, ll. 6-14; col. 8, ll. 1-18; col. 9, ll. 39-48). Chislenko discloses that the group of neighboring users of the system may be determined, at least in part, by "comparing that user's profile with the profile of every other user of the system" (*Id.* at col. 5, ll 51-55). Applicant notes, however, that the profiles in Chislenko are compared not to select a user from which the system can obtain a playlist, but to determine what other users rate items similarly, i.e., to determine the group of "neighboring users" (*Id.* at col. 8 ll. 1-18). Applicant's claimed invention, in contrast, compares profiles to determine a "matching user" and to select a playlist of the matching user. Chislenko fails to teach or suggest selecting a matching user. Chislenko likewise fails to teach or suggest selecting a playlist of a matching user, and delivering the playlist to the media player device.

The Patent Office concedes that Chislenko fails to disclose selecting a playlist of a matching user associated with a matching user profile (Office Action mailed February 2, 2009, p. 5). However, the Patent Office asserts that Chang discloses these limitations. Applicant respectfully disagrees. Chang relates to coordinated and synchronized music playback among peer devices (Chang, Abstract). Chang discloses a system wherein user profiles may comprise lists of songs (*Id.* at para. 21). If a list of songs of one user is sufficiently similar to a list of songs of another user, the system disclosed in Chang may determine that a profile match exists (*Ibid.*). A song that is common to both lists may then be played concurrently on each of the user devices associated with the users (*Id.* at para. 24). Nowhere does Chang disclose that subsequent to a match of user profiles a playlist of a matching user is selected and delivered to the media player device. Rather, Chang teaches playing the same song that the user already has identified in their respective profile. In this regard, Chang teaches away from selecting and delivering a

playlist to the media player device associated with the target user. This is because Chang is not concerned with locating and delivering playlists to a user. Rather, Chang is concerned with synchronized playback of a song on two devices. Applicant submits that combining the teachings of Chang with Chislenko would result in a system wherein a user of the system in Chislenko is recommended the same items that the user already rated highly. This would be inconsistent with the teachings of Chislenko, and therefore Applicant submits one would not be motivated to combine the teachings of Chang with Chislenko. However, even if the teachings of Chang were combined with those of Chislenko, neither Chislenko nor Chang, either alone or in combination, teach or suggest selecting a playlist of a matching user associated with a matching user profile and delivering the playlist to a media player device associated with a target user profile, as recited in Applicant's claim 61. Applicant's claims 78 and 89 contain similar limitations, and therefore submit that Applicant's claims 61, 78, and 89 are not rendered obvious by Chislenko and Chang, and respectfully request that the rejection be withdrawn.

Claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 are dependent claims ultimately based upon claims 61, 78, and 89, respectively. As such, claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 are allowable for at least the same reasons set forth above with respect to claims 61, 78, and 89. However, Applicant reserves the right to further address the rejection of claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Elliott

Claims 72, 82, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and U.S. Patent Application Publication No. 2005/0165888 A1 to Elliott (hereinafter "Elliott"). Applicant respectfully traverses. The standards for obviousness are set forth above. Claims 72, 82, and 91 are dependent claims ultimately based upon claims 61, 78, and 89, respectively. As such, claims 72, 82, and 91 are allowable for at least the same reasons set forth above with respect to claims 61, 78, and 89. However, Applicant reserves the right to further address the rejection of claims 72, 82, and 91 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Mercer

Claims 73 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and U.S. Patent Application Publication No. 2004/0078382 A1 to

Mercer et al. (hereinafter "Mercer"). Applicant respectfully traverses. The standards for obviousness are set forth above. Claims 73 and 83 are dependent claims ultimately based upon claims 61 and 78, respectively. As such, claims 73 and 83 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 73 and 83 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Chislenko and Shirwadkar

Claims 74 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of U.S. Patent Application Publication No. 2004/0162830 A1 to Shirwadkar et al. (hereinafter "Shirwadkar"). Applicant respectfully traverses. The standards for obviousness are set forth above. Claims 74 and 84 are dependent claims ultimately based upon claims 61 and 78, respectively. As such, claims 74 and 84 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 74 and 84 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Sakuma

Claims 76 and 86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and U.S. Patent Application Publication No. 2006/0256669 A1 to Sakuma et al. (hereinafter "Sakuma"). Applicant respectfully traverses. The standards for obviousness are set forth above. Claims 76 and 86 are dependent claims ultimately based upon claims 61 and 78, respectively. As such, claims 76 and 86 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 76 and 86 in the future, if needed.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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